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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,607	09/22/2003	Satoshi Suda	9868/1680-USO	9764
76808	7590	08/12/2010	EXAMINER	
Leason Ellis LLP 81 Main Street Suite 503 White Plains, NY 10601			MOSSER, ROBERT E	
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			3714	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/667,607

Applicant(s)

SUDA ET AL.

Examiner

ROBERT MOSSER

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-11, 14-20 and 22-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-11, 14-20 and 22-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/22/2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 2 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the substitution of a wild symbol for the particular symbol forming a winning combination, does not reasonably provide enablement for the "morphing" wild symbol. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

In particular the term morph denotes a transformation of the symbol from one state or thing into another yet the specification fails to describe this process in discussing a substitution of the particular symbol for a wild symbol. There is no language present in the specification as originally presented that would otherwise indicate that the applicant's substitution would otherwise incorporate a transformation required to link the disclosed substitution to a morphing of symbols as claimed. Appropriate correction is required.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the morphing of the

wild symbol into the particular symbol and vice versa as claimed must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3714

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **1-4, 6, 8-11, 18-20, 22, and 24-29** are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Bennett (US 6,419,579) in view of Cannon et al (US 5,766,074) in further view of Inoue (US 6,942,572), in yet further view of Yoseloff (US 6,311,976) in yet further view of Kaminkow (US 6,837,790).

Claims **1-2, 4, 6, 8, 10-11, 18, 20, 22, and 24-29**: Bennett teaches a gaming machine comprising:

a display module with multiple display areas contained therein for displaying a changing display including the changing of multiple symbols (reel spin feature) at the start of a game (*Bennett* Figure 1, Col 1:60-67);

a plurality of symbols including at least one wild symbol (*Bennett* Fig 3, Col 2:1-21);

the display of multiplication factor with the presentation of the wild symbol in combination with winning arrangements of symbols (*Bennett* Figure 3 Col 1:51-2:11, 2:42-44)

multiple win lines comprising a subset of the plurality of symbols (*Bennett* Col 3:25-35);

a static display of the plurality of symbols on multiple areas of the display module (*Bennett* Figure 1, Col 1:60-67); and

an evaluation module for identifying multiple winning arrangements of symbols and wild symbols on the display such that the wild symbol establishes multiple predefined wins (*Bennett* Figure 1, Col 4:29-5:25)

Though arguably implicit to the nature of gaming devices the prior art of *Bennett* does not explicitly describe the presentation of game symbols in a static array both prior to the initiation of a game and after the conclusion of a game. In a related teaching however, *Cannon* teaches the presentation of game symbols in a static array both prior to the initiation of a game and after the conclusion of a game as a series repeating games (*Cannon* Figure 3). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the repeated presentation of static symbol arrays before and after game plays as taught by *Cannon* into the invention of *Bennett* in order to provide the player with the ability to review game results for a previous game at a user selectable time period concluded in the player initiation of a subsequent game.

While the combination of *Bennett* & *Cannon* is arguably silent regarding visually differentiating the winning combinations generated on the display, the related invention of *Inoue* teaches the visual differentiation of winning combinations through the use of alternating different colors of illumination in a gaming machine to highlight multiple different winning outcomes including winning outcomes with common symbols (*Inoue*

Figure 4 Abstract Col 2:25-35, 6:25-45, 7:64-8:11). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the winning outcome identification features of Inoue into the combination of Bennett & Cannon in order to clearly present the winning game symbol results to the player thereby preventing confusion as taught by Inoue (*Inoue* Col 2:5-36)

In the combination of Bennett, Cannon, & Inoue, Inoue teaches the alternating identification different winning arrangements including the "repeated illumination" of symbols understood to implicitly require a time interval. The combination of Bennett, Cannon, & Inoue is silent regarding the utilization of a time interval to change a wild symbol present in a winning combination to other specific symbols that complete the winning arrangement however the related invention of Yoseloff teaches the morphing (a process understood to inherently include transformation over a time interval) of a wild symbol into a specific game symbol as to complete a winning combination (*Yoseloff* Col 8:44-46, 10:21-29, 11:22-37). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the wild symbol morphing features of Yoseloff into the combination of Bennett, Cannon, & Inoue in order to clearly present to the player the specific game symbol that the wild symbol is substituting.

Though the combination of Bennett, Cannon, Inoue, & Yoseloff teaches the gaming device as set forth above, the combination is silent regarding the incorporation of a vibration feature such that a display mechanism vibrates when a multiple win feature including a common wild symbol occurs. In a related invention however, Kaminkow teaches the inclusion of a vibration feature for vibrating displayed game

Art Unit: 3714

elements in an electronic wager game wherein the feature is further taught by Kaminkow as being readily adaptable to a plurality game trigger events (*Kaminkow* Col 2:16-37, 5:25-32). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the features of the vibration feature as taught by Kaminkow into the invention of Bennett, Inoue, and Yoseloff in order to provide the player with additional entertainment and excitement as taught by Kaminkow (*Kaminkow* Col 2:54-60). Claim language extending the vibration of game elements to a plurality of game symbols is understood as encompassed by the teachings of Kaminkow and in the alternative thereto representing an obvious duplication of parts (per MPEP 2144.04.VI.B) of Kaminkow in the combination of Bennett, Cannon, Inoue, Yoseloff & Kaminkow that would have been obvious to one of ordinary skill in the art at the time of invention to draw attention to the morphing transformation taking place and the additional payouts formed though the morphing of the game symbols provided by Yoseloff and Inoue in the combination of Bennett, Inoue, Yoseloff & Kaminkow.

Claim **3, 9, and 19**: In addition to the presentation of Yoseloff as presented above Bennett teaches the sequential displaying of multiple winning arrangements with a changing wild symbol, in which multiple wins are established (*Bennett* Col 4:29-5:25).

Claims **7, 14-17, and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Bennett (US 6,419,579) in view of Cannon et al (US 5,766,074) in further view of Inoue (US 6,942,572), in yet further view of Yoseloff

(US 6,311,976), Kaminkow (US 6,837,790) as applied to claims **1-4, 6, 8-11, 18-20, 22,** and **24-29** above and further in view of Hamano (US 5,205,555).

Though teaching teaches the gaming device as set forth above, the combination of Bennett, Cannon, Inoue, Yoseloff, & Kaminkow is silent regarding the incorporation of multiplier that are predetermined based on the symbol combination. In a related invention however, Hamano teaches the inclusion of predefined multipliers resultant on the arrangement of game symbols in a multi-reel slot machine (*Hamano* Figures 15-16, Col 1:38-2:39) to make a slot machine game more entertaining and a more exciting experience. It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the predefined multipliers resultant on the arrangement of game symbols of Hamano into the combination of Bennett, Cannon, Inoue, Yoseloff, & Kaminkow in order to make a slot machine game more entertaining and a more exciting experience as taught by Hamano.

Response to Arguments

Applicant's arguments dated May 25th, 2010 with respect to claims **1-4, 6-11, 14-20,** and **22-29** have been considered but are not persuasive.

On the first two pages of the applicant's remarks the applicant challenges the rejection of claims under 35 USC 112 and Objection to Drawings based on the alleged removal of the claimed subject matter directed to the morphing of game symbols. Upon review of the claims however upon review of the claims, claim 2 remains to include

claim language directed to the morphing of game symbols. According the afore mentioned rejection under 35 USC 112 and Objection to Drawings is maintained with respect to claim 2.

On pages 2 through 5 of the applicant's remarks the applicant challenges the rejection of record under 35 USC 103 under various particular arguments.

Commencing on page three of the applicant's remarks the applicant argues that the claims as so amended recognizes and differentiates winning patterns including wild symbols from other winning arrangements that do not include a wild type symbol. Upon review of the claims and the prior art of record (including the newly applied prior art of Cannon) the claimed subject matter is found to read on the prior art that differentiates each respective winning arrangement from one another regardless if the winning arrangement in question contains a wild or shared wild symbol (See Inoue & Yoseloff as cited and applied in the rejections above). Alternatively stated, a game machine that comprises a differentiation function based on the presence of a wild symbol does not speak to a performing a differing course of action if the winning arrangement does not include a wild symbol. Though the applicant's argument suggest a -consisting of- type of claim interpretation/construction, the pending claim language does not presently support the narrower claim interpretation. Accordingly as the presented claim language would necessarily include the prior art arrangement that differentiates each winning combination from one another the applicant's argument with regards to this aspect is respectfully not persuasive.

Following from the above on page 4 of the applicant's remarks, the applicant argues that the claim language describing the "morphing" of wild symbols in an alternate fashion is not allegedly provided for by the combination of prior art. However as presented in the applied prior art, Yoseloff teaches the visual transformation of game symbols (morphing) while the prior art of Inoue teaches the visual modification of game symbols in an alternate manner. Accordingly the applicant's arguments are non-persuasive as the two described game features are provided for by the combination of prior art as presented herein above.

Continuing in the third full paragraph of page 4 the applicant argues the particular prior art of Humano for allegedly not providing a multiplier attached to a wild symbol. The feature of providing a multiplier attached to a particular wild symbol however is provided for by the base reference of Bennett as cited above while the reference of Humano teaches considering the cumulative number of symbols form a winning arrangement for deriving a cumulative multiplication factor. According, the applicant's argument against the prior art reference of Humano is non-persuasive as the argument addresses the Humano reference individually, and one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **ROBERT MOSSER** whose telephone number is (571)272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on (571) 272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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